



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appl. No. : 10/087,112
Applicant : Fuqiang Jin et al.
Filed : March 1, 2002
TC/A.U. : 1600/1624
Examiner : Thomas C. McKenzie
Title : Method for the synthesis of 2',3'-dideoxy-2',3'-didehydronucleosides

Docket No. : 08841.105031 (PHAR2001)
Customer No. : 20786

Office of Petitions
Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

October 26, 2004

PETITION UNDER 37 CFR 1.47(A)

Sir:


A Notice of Allowance was issued in the above application on July 28, 2004. In paragraph 2 of the statement of Reasons for Allowance, Applicants were requested to provide a substitute Declaration of Inventor Jin. The Examiner indicated that failure to file a substitute Declaration will result in Abandonment of the application.

The undersigned counsel was unable to locate Mr. Jin, who is apparently in China. Therefore, co-inventor Pasquale N. Confalone, through the undersigned agent, petitions the Commissioner to accept this application for prosecution without the oath of co-inventor Fuqiang Jin. The Commissioner is hereby authorized to charge the required Petition fee under 37 C.F.R. §1.17(h) of \$130.00, as well as any other deficiencies or required fees to Deposit Account No. 11-0980. Applicants also enclose an executed substitute Declaration of joint inventor Pasquale

CERTIFICATE OF FACSIMILE TRANSMISSION (37 CFR 1.8a)

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10/26/04
Date



Susanne Hollinger

Appl. No. 10/087,112
Amendment Dated October 22, 2004
Reply to Notice of Allowance dated July 28, 2004

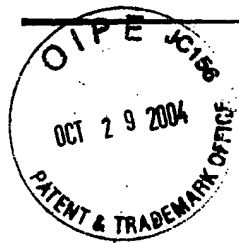
N. Confalone on behalf of himself and inventor Jin, and proof of pertinent facts relating to this Petition, as required by 37 C.F.R. §1.47.

Applicants request expedited entry of this petition.

Respectfully submitted,


Sherry M. Knowles, Esq.
Reg. No. 33,052

KING & SPALDING LLP
191 Peachtree Street, 45th Floor
Atlanta, Georgia 30303-1763
Tel.: (404) 572-4600



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Alexandria, VA 22313-1450

October 26, 2004

DECLARATION OF SALLY K. SEXTON

Sir:

1. My name is Sally Sexton. I am a paralegal employed by King & Spalding, LLP, the firm of record responsible for the above-identified application.

2. Our firm received an Office Action dated November 25, 2003 in the above-referenced application. In the Action, the Examiner objected to Dr. Fuqiang Jin's Declaration because the inventor had changed his address without initialing the change. To address the Examiner's objection, I attempted to locate the inventor to obtain a substitute Declaration.

3. The technology described in this application was originally developed at Dupont Pharmaceuticals, Inc., by Fuqiang Jin and Pasquale Confalone. In 2001, Dupont sold its pharmaceutical arm to Bristol Myers Squibb, including this patent filing. After the sale, Bristol Myers assigned the patent filing to Pharmasset, Ltd.

4. At the time of filing of the original Declaration, Dr. Jin had already left Dupont. The last address that we had in our files for him was the Massachusetts address identified in the original Declaration.

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Suzanne Hollinger

5. In November and December 2003, I spoke with Bryce A. Roberts, counsel for Pharmasset, regarding the possibility of obtaining a substitute Declaration from inventor Jin. Mr. Roberts stated that he had attempted to locate Mr. Jin through his contacts at Dupont and that he was unsuccessful in obtaining a new address or contact information for the inventor.

6. In a final Office Action dated May 5, 2004, the Examiner again objected to Dr. Jin's Declaration. At that time, I searched several databases to determine if I could locate Dr. Jin's new address but found no addresses listed for Dr. Jin. I also spoke to Mr. Roberts again to inquire whether he was able to locate the inventor. He stated that he was unable to identify a new address.

7. In the Notice of Allowance, dated July 28, 2004, the Examiner again rejected the originally filed Declaration and required a newly signed Declaration for Inventor Jin. In response, I again searched a proprietary database. On October 19, 2004, I identified two addresses for a Fuqiang Jin, one at 1002 Canter Cir., New Hope, PA 18938, and the other at 109 White Pine Cir., Trenton, NJ 08648. I relayed this information to Susanne Hollinger, a patent agent at our firm.

8. I declare that all statements made herein of my own knowledge are true and that all statements made herein of my own knowledge are believed to be true. These statements are made with the knowledge that willful false statements are punishable by fine or imprisonment under §1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issuing therefrom.

10/26/04
Date

Sally K. Sexton
Ms. Sally K. Sexton

King & Spalding, LLP
191 Peachtree Street
Atlanta, Georgia 30303
Telephone: 404-572-3478
Facsimile: 404-572-5145



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October 26, 2004

DECLARATION OF SUSANNE HOLLINGER

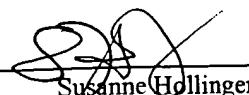
Sir:

1. My name is Susanne Hollinger. I am a patent agent employed by King & Spalding, LLP, the firm of record for the above-identified application.
2. Our firm received Office Actions dated November 25, 2003, and May 5, 2004, in which the Examiner rejected the originally filed Declaration of Inventor Jin because his address was changed on the Declaration and the change was not properly initialed. We were unable to locate Dr. Jin when preparing responses to those Office Actions.
3. On July 28, 2004 we received a Notice of Allowance. In the Statement of Reasons for Allowance, the Examiner again rejected the original Declaration and stated that the application would become abandoned unless a substitute Declaration was provided before payment of the issue fee.

CERTIFICATE OF FACSIMILE TRANSMISSION (37 CFR 1.8a)

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10/26/04
Date


Susanne Hollinger

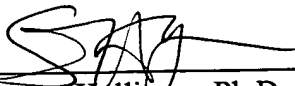
4. Between November, 2003 and October 2004, I was in contact with Ms. Sally Sexton, a paralegal in our firm and Mr. Bryce A. Roberts, counsel for Pharmasset, Inc., the assignee of record in an attempt to locate the inventor. During that time, we were unsuccessful in locating the inventor.

5. On October 19, 2004, Ms. Sexton informed me that she had identified two potential addresses for Dr. Jin, one at 1002 Canter Cir., New Hope, PA 18938, and the other at 109 White Pine Cir., Trenton, NJ 08648. Based on this information, I searched the internet white pages for a phone number that was associated with a "Jin" in either New Hope or Trenton. I found one instance of a Fugiang Jin listed in New Hope, Pennsylvania.

6. I attempted to contact Dr. Jin at the listed number of (215) 794-8756 and spoke with a woman who stated that she was his wife. When I explained that we needed to locate Dr. Jin in order to obtain his signature on a substitute Declaration, she stated that he was in China on contract manufacturing work and that he would not return before December 2004, at the earliest, and gave no definite date of return. She also stated that, due to his work situation, it would not be possible to contact him before this time.

7. I declare that all statements made herein of my own knowledge are true and that all statements made herein of my own knowledge are believed to be true. These statements are made with the knowledge that willful false statements are punishable by fine or imprisonment under §1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issuing therefrom.

10/26/04
Date



Susanne Hollinger, Ph.D.
Registration No. 51,811

King & Spalding, LLP
191 Peachtree Street
Atlanta, Georgia 30303
Telephone: 404-572-3478
Facsimile: 404-572-5145



Attorney's Docket No. PHAR 2001 US

SUBSTITUTE DECLARATION FOR UTILITY PATENT APPLICATION AND POWER OF ATTORNEY

In re Application of: **Fuqiang Jin and Pasquale N. Confalone**

As a below named inventor, I hereby declare that my residence, post office address and citizenship are as stated below next to my name. I believe I am an original, first and joint inventor of the subject matter which is claimed and for which a patent is sought on the invention entitled: "*Method for the Synthesis of 2',3'-Dideoxy-2',3'-Didehydronucleosides*" the specification of which was filed with the U.S. Patent and Trademark Office as U.S. Patent Application No. 10/087,112 on March 1, 2002.

On behalf of joint inventor Fuqiang Jin and myself, I hereby state that I have reviewed and understand the contents of the above-identified specification, including the claims, as amended by any amendment referred to above. I do not know and do not believe that the same was ever known or used by others in the United States of America before my or our invention thereof, or patented or described in any printed publication in any country before my or our invention thereof or more than one year prior to the date of this application. I further state that the invention was not in public use or on sale in the United States of America more than one year prior to the date of this application. *I understand that I have a duty of candor and good faith toward the Patent and Trademark Office, and I acknowledge the duty to disclose information which is material to the examination of this application in accordance with Title 37, Code of Federal Regulations, §1.56.*

I hereby claim foreign priority benefits under Title 35, United States Code, §119 (a)-(d) of the foreign application(s) for patent or inventor's certificate listed below, and have also identified below any foreign application for patent or inventor's certificate disclosing subject matter in common with the above-identified specification and having a filing date before that of the application on which priority is claimed:

| <u>Application No.</u> | <u>Country</u> | <u>Filing Date</u> | <u>Priority Claimed Under 35 USC §119</u> |
|------------------------|----------------|--------------------|---|
| <u>None</u> | | | |

I hereby claim the benefit under Title 35, United States Code, § 119(e) of any United States provisional application(s) listed below:

| <u>60/272,441</u> | <u>March 1, 2001</u> | <u>60/272,434</u> | <u>March 1, 2001</u> |
|-------------------|----------------------|-------------------|----------------------|
| (Application No.) | (Filing Date) | (Application No.) | (Filing Date) |
| | | | |

I hereby claim the benefit under Title 35, United States Code, §120 of any United States application(s) listed below and, insofar as the subject matter disclosed and claimed in the present application is not disclosed in the prior United States application in the manner provided by the first paragraph of Title 35, United States Code §112, I acknowledge the duty to disclose material information as defined in Title 37, Code of Federal Regulations, §1.56 which became available between the filing date of the prior application and the national or PCT international filing date of this application:

| <u>Application Serial No.</u> | <u>Filing Date</u> | <u>Status: patented, pending, abandoned</u> |
|-------------------------------|--------------------|---|
| <u>None</u> | | |

I further declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statement were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patents issuing thereon.

POWER OF ATTORNEY: The following are hereby appointed to prosecute this application and transact all business in the Patent and Trademark Office connected therewith: Sherry M. Knowles-33,052; W. Scott Petty-35,645; Clark G. Sullivan-36,942; Holmes J. Hawkins-38,913; Steven P. Wigmore-40,447; Lisa K. Norton-44,977; Charles E. Peeler-45,004; Joseph M. Bennett-Paris-47,226; Shane A. Nichols-43,836; Bob Neufeld-48,394; Josephine Young 48,308; Bill Isaacs-44,165; Stephanie D. Adams-47,378; Susanne Hollinger 51,811.

Send correspondence to: Sherry M. Knowles
King & Spalding
191 Peachtree Street, N.E., 45th Floor
Atlanta, Georgia 30303

Direct telephone calls at (404) 572-4600
Sherry M. Knowles

I understand that Inventor Fuqiang Jin is currently unavailable to sign a substitute Declaration and I hereby sign on his behalf.

| | |
|---|-----------------|
| Full name of joint inventor: Pasquale N. Confalone | Citizenship: US |
| Inventor's signature: <i>Pasquale N. Confalone</i> | Date: 10/26/04 |
| Residence and Post Office Address: 308 Centennial Circle, Greenville, Delaware 19807, USA | |

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KING & SPALDING LLP

191 Peachtree Street
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Telephone: 404/572-4600
Facsimile: 404/572-5100
www.kslaw.com

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www.kslaw.com

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FROM: Susanne Hollinger

7840

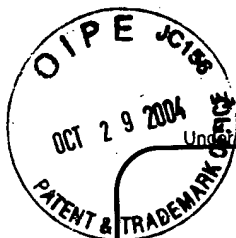
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Total Number of Pages in This Submission

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|------------------------|---------------------|
| Application Number | 10/087,112 |
| Filing Date | March 1, 2002 |
| First Named Inventor | Fuqiang Jin, et al. |
| Art Unit | 1600/1624 |
| Examiner Name | Thomas C. McKenzie |
| Attorney Docket Number | 08841.105031 |

ENCLOSURES (Check all that apply)

| | | |
|--|---|--|
| <input type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input type="checkbox"/> Amendment/Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Reply to Missing Parts/ Incomplete Application <input type="checkbox"/> Reply to Missing Parts under 37 CFR 1.52 or 1.53 | <input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input checked="" type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation <input type="checkbox"/> Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____ <input type="checkbox"/> Landscape Table on CD | <input type="checkbox"/> After Allowance Communication to TC <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input type="checkbox"/> Other Enclosure(s) (please identify below): |
| Remarks Petition under 37 CFR 1.47(a), substitute declaration and statement of facts | | |

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

| | | | |
|--------------|-------------------------|----------|---------|
| Firm Name | King & Spalding, LLP | | |
| Signature | | | |
| Printed name | Sherry M. Knowles, Esq. | | |
| Date | | Reg. No. | 33, 052 |

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|-----------------------|-------------------|------|----------|
| Signature | | | |
| Typed or printed name | Susanne Hollinger | Date | 10/26/04 |

This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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